

R E M A R K S

Claims 1 - 42 were pending in the present application.

Claims 1 - 44 are now pending, new claims 43 and 44 having been added in this paper.

Claims 1, 34, 36, 38, 40, 41, 43 and 44 are independent.

I. Independent and Dependent Claims

Applicants note that at the beginning of page 4 of the Office Action, the Examiner characterized claims 34, 38 and 41 as dependent claims. They are actually independent claims and accordingly Applicants will pay the appropriate fees if they have not already been paid.

For example, claim 41 is independent, not dependent on claim 40. A claim is dependent if it cannot conceivably be infringed by anything which would not also infringe the independent claim. MPEP 608.01(n)(III). In other words, if a claim were infringed by something that does not infringe the independent claim, then that claim is not dependent on the independent claim - it is also an independent claim.

Claim 41 is independent. Claim 41 is not dependent on independent claim 40 because one could infringe claim 41 without infringing claim 40. Note that the apparatus of claim 41 is capable of performing the method of claim 40, but need not actually perform the method. For example, one could infringe claim 41 by making or selling the claimed apparatus without ever activating the apparatus. Since the apparatus is not activated, it does not perform the method claimed in claim 40, and thus claim 40 cannot be infringed even though claim 41 is infringed.

II. Section 112 Rejections

Claims 5, 35, 39 and 42 stand rejected as being indefinite. Applicants respectfully traverse the Examiner's Section 112 rejection.

Claims 5, 35, 39 and 42 have been amended to correct the discrepancies noted by the Examiner.

III. Section 103(a) Rejections

Claims 1 - 42 are rejected as being unpatentable over U.S. Patent No. 5,544,784 to Malaspina in view of U.S. Patent No. 5,918,213 to Bernard et al. Applicants respectfully traverse the Examiner's Section 103(a) rejection.

A. Independent Claim 1

The Examiner states that Malaspina shows "elements that suggest" the limitations of claim 1. In particular, the Examiner cites, without elaboration, certain portions of Malaspina, namely FIGS. 1 - 3 and 5; the Abstract; col. 2, lines 44 - 67; col. 3, lines 1 - 56; col. 4, lines 33 - 45; and col. 6, lines 15 - 17.

A(1). Malaspina does not suggest an "alternate product offer"

From this brief rejection, Applicants are unsure which limitations the Examiner believes to be suggested by which portions of Malaspina. However, it is clear that Malaspina does not disclose, suggest or even hint at an "alternate product offer". Accordingly, the various limitations of claim 1 that involve an "alternate product offer" (i.e., virtually every step of claim 1) cannot be suggested by Malaspina.

The portions of Malaspina referred to by the Examiner are devoid of any suggestion of any offer at all, much less an "*alternate product offer*", and much less any of the limitations of claim 1 that involve an "*alternate product offer*".

FIG. 1 of Malaspina is a block diagram of a vending machine system. It shows components such as a central control unit and a customer interface.

FIG. 2 of Malaspina is a perspective cutaway view of a vending machine. It shows components such as an interface unit, which includes a money handling unit, a display, and an input means such as entry pad for generating selection information.

FIG. 3 of Malaspina is a perspective view of a vending machine much like FIG. 2, but further including a communications relay station having an antenna for receiving and transmitting short range communications signals.

FIG. 5 of Malaspina is a block diagram of a battery pack dispensing sub-system. It includes a new battery reservoir, battery dispensing unit, recharged battery reservoir, battery handler, and battery delivery port.

The Abstract of Malaspina generally describes a vending machine for vending a rechargeable battery pack. A customer can purchase a new battery or exchange a discharged battery for a fully charged one of similar condition.

Col. 2, lines 44 - 67 and col. 3, lines 1 - 56 of Malaspina generally describe the components illustrated in FIGS. 1 and 2, described above.

Col. 4, lines 33 - 45 of Malaspina generally describes the housing and power cable of the vending machine.

Col. 6, lines 15 - 17 of Malaspina states that "numerous delivery systems are currently employed by an automatic teller and vending machines, and the technology associated with them is easily applicable here."

A(2). Bernard does not suggest an "*alternate product offer*"

Bernard likewise does not disclose, suggest or even hint at an "*alternate product offer*". Accordingly, the various limitations of claim 1 that involve an "*alternate product offer*" (i.e., virtually every step of claim 1) cannot be suggested by Bernard.

The portions of Bernard referred to by the Examiner (FIGS. 24, 25 and 44) are devoid of any suggestion of any offer at all, much less an "*alternate product offer*", and much less any of the limitations of claim 1 that involve an "*alternate product offer*".

FIG. 24 of Bernard is a flow diagram illustrating a process by which a particular idol of a chosen artist is selected.

FIG. 25 of Bernard is a flow diagram illustrating a process by which a selected artist only has one title.

FIG. 44 of Bernard is a flow diagram illustrating a process by which an automated in-store order fulfillment center operates.

The Examiner contends that the cited portions of Bernard suggest the claimed step of:

dispensing a second product that corresponds to said product selection if the customer has not so accepted

However, since the cited portions of Bernard suggest neither:

an alternate product offer

nor

determining if the customer has accepted said alternate product offer

they cannot suggest the claimed step of:

dispensing a second product that corresponds to said product selection if the customer has not so accepted

B. Independent Claims 34, 36, 38 and 40

Independent claims **34, 36, 38 and 40** are "rejected for substantially the same reasons as claim 1". Accordingly, since claim 1 is patentable over the references as described above, independent claims **34, 36, 38 and 40** is likewise patentable.

Claim **34** includes the limitations of "*an alternate product offer*" through its reference to claim 1.

Claim **36** includes various limitations directed to "*an alternate product offer*" and "*an alternate product offer rule associated with an original product selection*". It is clear that Malaspina and Bernard do not disclose, suggest or even hint at such limitations. Accordingly, the various limitations of claim **36** that involve such limitations (i.e., virtually every step of claim **36**) cannot be suggested by Malaspina and Bernard.

Claim **38** includes the limitations of "*an alternate product offer*" and "*an alternate product offer rule associated with an original product selection*" through its reference to claim **36**.

Claim **40** includes various limitations directed to "*an alternate product offer*". As described above, it is clear that Malaspina and Bernard do not disclose, suggest or even hint at such a limitation. Accordingly, the various limitations of claim **40** that involve "*an alternate product offer*" (i.e., virtually every step of claim **40**) cannot be suggested by Malaspina and Bernard.

C. Independent Claim 41

Independent claims **41** is "rejected for substantially the same reasons as claim 40". Claim **41** includes the limitations of "*an alternate product offer*" through its reference to claim **40**. Accordingly, since claim **40** is patentable over the references as described above, independent claim **41** is likewise patentable.

In addition, the Examiner has taken Official Notice on page 31 of the Office Action that various limitations of claim **41** "were expected in the art by one of ordinary skill... because such applications were well known in the art".

From the Official Notice described on page 31 of the Office Action, Applicants cannot properly determine what exactly is alleged as being well known. Accordingly, Applicants cannot precisely describe how the present invention would distinguish over this material since the exact nature of the material is unstated. Accordingly, Applicants request a reference to more describe the official noted subject matter in more detail. MPEP 2144.03.

D. Dependent Claims.

The remaining claims rejected under 35 U.S.C. § 103(a) are dependent on claims previously described as patentable. Accordingly, these claims are likewise patentable.

E. No Motivation to Combine Malaspina and Bernard

Malaspina is directed to a machine for vending a rechargeable battery pack. Bernard is directed to an automated product purchasing and previewing system which allows customers to shop for and purchase products via a remote communications medium.

The two references are not analogous. Further, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine references in the manner proposed by the Examiner.

The Examiner suggests on page 5 of the Office Action that one would combine Malaspina and Bernard because "such a combination would have provided a means of 'browsing to learn more about products which are popular or in great demand but about which the customer may not be aware.'" This "motivation" is unrelated to either Malaspina or the present invention, and is accordingly not a proper motivation to make the proposed combination.

IV. Newly Added Claims 43 and 44

Newly added Claims **43 and 44** distinguish over the references cited by the Examiner, alone or in combination.

For example, claim **43** recites *presenting an offer for a second product in lieu of a first product* which is selected. The references do not suggest such a limitation.

For example, claim **44** recites *displaying an offer to for the second product instead of the first product* which is selected. The references do not suggest such a limitation.

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

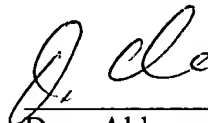
Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

Petition for Extension of Time to Respond

Applicants hereby petition for a **three-month** extension of time with which to respond to the Office Action. Please charge \$890.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



Dean Alderucci
Attorney for Applicants
Registration No. 40,484
Alderucci@walkerdigital.com
Walker Digital Corporation
Five High Ridge Park
Stamford, CT 06905-1326
203-461-7337 / voice
203-461-7300 / fax

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Date

C L A I M A M E N D M E N T S
M A R K E D U P F O R M

Please **AMEND** the claims as follows:

5. (AMENDED) A method according to Claim 4 **[5]**, wherein step (b3) includes the step of:

(i) determining that said product selection qualifies for an alternate product offer if said acceptance rate is greater than a predetermined value.

35. (AMENDED) A storage device according to Claim **34**, wherein said storage device is selected from the group consisting of computer RAM, computer ROM, a PROM chip, flash RAM, a ROM card, a RAM card, a floppy disk, a magnetic disk, a magnetic tape, a magneto-optical disk, an optical disk, a CD-ROM disk, and [or] a DVD disk.

39. (AMENDED) A storage device according to Claim **38**, wherein said storage device is selected from the group consisting of computer RAM, computer ROM, a PROM chip, flash RAM, a ROM card, a RAM card, a floppy disk, a magnetic disk, a magnetic tape, a magneto-optical disk, an optical disk, a CD-ROM disk, and [or] a DVD disk.

42. (AMENDED) A vending machine apparatus according to Claim **41**, wherein said message output device includes at least one element selected from the group consisting of an audio speaker, an LED display, an LCD display, a video display device, a touch sensitive video display device, and [or] a printer.

New Claims **43 and 44** have been added.